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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,483	01/27/2004	Gun-il Lee	1793.1183	6277
21171 7590 01/22/2009 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER NGUYEN, ALLEN H				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/764,483

Applicant(s)

LEE, GUN-IL

Examiner

Allen H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/16/2008 has been entered.

Response to Arguments

2. Applicant's arguments filed 12/16/2008 have been fully considered but they are not persuasive.

3. With respect to applicant's argument that "Berkema does not obviate the technical feature of claim 6 where the security information is transmitted via a security communication line different from a communication line that transmits the document data from the transmitting facsimile machine to the receiving facsimile machine".

In reply: Regarding claim 6, Debry '728 does not explicitly show wherein the security information is transmitted via a security communication line different from a communication line that transmits the document data from the transmitting machine to the receiving machine.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Berkema '072. In particular, Berkema '072 teaches wherein the security information is transmitted via a security communication line different from a communication line that transmits the document data from the transmitting machine to the receiving machine (data line and security lines are different. One from phone, the other from computer: a step of the PDA 402/Receiver machine establishing a link 404 with the print device 406, and the print device 406 / transmitter machine acknowledging the PDA 402 over the link 404. Further steps are comprised of the PDA establishing a communications link 412 with the location 414 / security server; Page 6, paragraph [0053], fig. 4).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeBry (US 6,385,728) in view of Berkema et al. (US 2003/0002072), and further in view of Stodder et al. (US 5,727,890).

Regarding claim 6, DeBry '728 discloses a method (Figs. 1, 5) of selectively printing document data (Document Source 10, fig. 1) using a security

server (Certificate Authority 60, fig. 4) for machines (User 20 / Print System 30, fig. 4), which provides security information on users (i.e., a certificate authority 60 to authenticate the user's digital certificate; Col. 9, lines 19-20) who are authorized to print document data transmitted from a transmitting facsimile machine (i.e., a fax machine may be understood to be a network printer; Col. 12, line15-20, fig. 3, Print Server 30) to a receiving machine (User/Client 20, fig. 3), to the receiving machine (The User / Client 20, fig. 3), the method comprising:

storing the security information on the security server (i.e., the authority 60 includes a public key in the certificate given to the printer and encodes the corresponding private key with the secret key from the database; Col. 9, lines 63-65);

transmitting the security information (i.e., the printer may then send, 402, the public key and user identification to a certificate authority 60 to authenticate the user's digital certificate. The print system now has the user's public key and knows that it is authenticated. The printer sends, 403, to the user a random message; See col. 9, lines 18-23, fig. 4) and the document data (Document is spooled 525, fig. 5) to the receiving machine (User 20, fig. 4) from the transmitting machine (Print System 30, fig. 4);

receiving user information on a user attempting to print the document data (i.e., the user encrypts the message with its private key and sends, 404, it back to the printer; Col. 9, lines 23-24) at the receiving facsimile machine (User 20, fig. 4);

authenticating the user based on a result of comparing the received user

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information with the security information (i.e., the print system decrypts the message with the user's public key. If it matches the original message, then the printing system knows that the user is who the user purports to be; Col. 9, lines 24-27);

printing the document data if the user is authenticated at the receiving machine (i.e., the printer has verified the authentication and authority of the user 20, the printer sends a file request to the server along with the will-call certificate, which is now encrypted document with the printer's private key; Col. 9, lines 35-40),

Debry '728 does not explicitly show wherein the security information is transmitted via a security communication line different from a communication line that transmits the document data from the transmitting machine to the receiving machine.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Berkema '072. In particular, Berkema '072 teaches wherein the security information is transmitted via a security communication line different from a communication line that transmits the document data from the transmitting machine to the receiving machine (data line and security lines are different. One from phone, the other from computer: a step of the PDA 402/Receiver machine establishing a link 404 with the print device 406, and the print device 406 / transmitter machine acknowledging the PDA 402 over the link 404. Further steps are comprised of the PDA establishing a communications link 412 with the location 414 / security server; Page 6, paragraph [0053], fig. 4).

In view of the above, having the system of DeBry and then given the well-established teaching of Berkema, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of DeBry as taught by Berkema to include: wherein the security information is transmitted via a security communication line different from a communication line that transmits the document data from the transmitting machine to the receiving machine, since a modification would be allowing to securely provide the printed matter produced according to the specific print job to the user who directed the print job.

The combination of DeBry '728 and Berkema '072 does not explicitly show printing document data for facsimile machines.

However, the above-mentioned claimed limitations are well known in the art as evidenced by Stodder '890. In particular, Stodder '890 teaches printing document data for facsimile machines (i.e., a multiple-function printer/fax machine which is primarily a printer peripheral for a computer as well as primarily a fax machine, having an integrated, shared paper path and common mechanisms including a common chassis for scanning documents on the one hand and for producing hardcopy printout sheets on the other hand; Col. 2, lines 20-30).

In view of the above, having the system of DeBry and Berkema and then given the well-established teaching of Stodder, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of DeBry and Berkema as taught by Stodder to include:

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printing document data for facsimile machines, since Stodder stated in col. 1, lines 40-50 that such a modification would ensure a fax machine acts primarily as both a sender and receiver of documents, and that the fax machine also acts secondarily as a printer and secondarily as a convenience copier.

Regarding claim 7, DeBry '728 discloses the method, wherein the security information includes at least a plurality of identifications and passwords of the authorized users (i.e., access to resources of a computer system ("server") from another system or user ("user") has been controlled through passwords. This requires the server to maintain a database of all authorized users and each user's password; Col. 4, lines 15-20).

Regarding claim 8, DeBry '728 discloses the method, wherein the authenticating the user (User 20, fig. 4) based on a result of comparing the received user information (Digital Certificate, fig. 4) with the security information (Authenticates Certificate 402, fig. 4) comprises:

providing the received user information to the security server (i.e., in a certificate-based access control system, the server only needs to authenticate certificates issued by a certification authority; Col. 4, lines 22-24);

enabling the security server for the facsimile machines to determine whether to authenticate the unauthorized user based on a result of comparing the received user information with the security information and to inform the receiving facsimile machine of a result of the determination (i.e., to gain access

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to resources of the server, the user submits the user's certificate. From the certificate, which contains data that cannot be forged, the server can obtain the user's authenticated public number, personal data, and access privileges. The server can then transmit to the user a random message that the user must digitally sign with the user's private number and return it to the server. The server can then authenticate the digital signature using the public number in the certificate and check that the signed message is the same it sent to the user. With this digitally-signed response, the server can determine if the user has the correct private number corresponding to the authenticated public number in the certificate; See col. 4, lines 25-40).

Debry '728 does not explicitly show for using the facsimile machines.

However, the above-mentioned claimed limitation is well known in the art as evidenced by Stodder '890. In particular, Stodder '890 teaches for using the facsimile machines (i.e., a multiple-function printer/fax machine which is primarily a printer peripheral for a computer as well as primarily a fax machine, having an integrated, shared paper path and common mechanisms including a common chassis for scanning documents on the one hand and for producing hardcopy printout sheets on the other hand; Col. 2, lines 20-30).

In view of the above, having the system of Debry and then given the well-established teaching of Stodder, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Debry as taught by Stodder to include: using the facsimile machines, since Stodder stated in col. 1, lines 40-50 that such a modification would ensure

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a fax machine acts primarily as both a sender and receiver of documents, and that the fax machine also acts secondarily as a printer and secondarily as a convenience copier.

Regarding claim 9, DeBry '728 discloses the method, wherein the authenticating the user (User 20, fig. 4) based on a result of comparing the received user information (Digital Certificate, fig. 4) with the security information (Authenticates Certificate 402, fig. 4) comprises:

providing the received user information to the transmitting facsimile machine (i.e., the Print System 30 can obtain the user's authenticated public number, personal data, and access privileges; Col. 4, lines 28-30);

enabling the transmitting facsimile machine (i.e., a fax machine may be understood to be a printer; Col. 12, lines 20-21, fig. 4, Print System 30) to determine whether to authenticate the unauthorized user or not based on a result of comparing the received user information with the security information and to inform the receiving machine (User/Client 20, fig. 4) of a result of the determination (i.e., a user 20/Receiving Machine will request the document from the Print System 30, the Print System will verify that the user has the correct access privileges, and if so, then the Print System will send a copy of the document to the user; col. 4, lines 50-55).

DeBry '728 does not explicitly show the receiving machine is fax machine.

However, the above-mentioned claimed limitation is well known in the art as evidenced by Stodder '890. In particular, Stodder '890 teaches the receiving

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machine is fax machine (i.e., a multiple-function printer/fax machine which is primarily a printer peripheral for a computer as well as primarily a fax machine; Col. 2, lines 21-23).

In view of the above, having the system of Debry and then given the well-established teaching of Stodder, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Debry as taught by Stodder to include: the receiving machine is fax machine, since Stodder stated in col. 1, lines 40-50 that such a modification would ensure Facsimile devices (i.e., fax machines) have been used for many years, to transmit documents containing text or graphical images through a modem via telephone lines through another modem to a remote destination.

Regarding claim 10, DeBry '728 discloses the method, wherein the authenticating the user (User 20, fig. 4) based on a result of comparing the received user information (Digital Certificate, fig. 4) with the security information (Authenticates Certificate 402, fig. 4) comprises:

providing the received user information to the receiving machine (i.e., the Print System 30 can transmit to the user a random message that the user must digitally sign with the user's private number and return it to the Print server; Col. 4, lines 30-32, fig. 4);

enabling the receiving facsimile machine to determine whether to authenticate the unauthorized user or not based on a result of comparing the received user information with the security information and to inform the receiving

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machine of a result of the determination (i.e., the server can then authenticate the digital signature using the public number in the certificate and check that the signed message is the same it sent to the user. With this digitally-signed response, the server can determine if the user has the correct private number corresponding to the authenticated public number in the certificate).

Debry '728 does not explicitly show the receiving machine is fax machine.

However, the above-mentioned claimed limitation is well known in the art as evidenced by Stodder '890. In particular, Stodder '890 teaches the receiving machine is fax machine (i.e., a multiple-function printer/fax machine which is primarily a printer peripheral for a computer as well as primarily a fax machine; Col. 2, lines 21-23).

In view of the above, having the system of Debry and then given the well-established teaching of Stodder, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify the system of Debry as taught by Stodder to include: the receiving machine is fax machine, since Stodder stated in col. 1, lines 40-50 that such a modification would ensure Facsimile devices (i.e., fax machines) have been used for many years, to transmit documents containing text or graphical images through a modem via telephone lines through another modem to a remote destination.

Regarding claim 11, DeBry '728 discloses a computer-readable medium encoded with processing instructions implementing the method (i.e., having computer-readable program code, may be embodied within one or more

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computer-usable media such as memory devices or transmitting devices, thereby making a computer program product; Col. 11, lines 20-25) of selectively printing document data (File Source 10, fig. 3) using a security server (Certificate Authority 60, fig. 4), which provides security information on users who are authorized to print document data transmitted from a transmitting facsimile machine (i.e., a fax machine may be understood to be a printer; Col. 12, line 19-20, fig. 3, Print Server 30) to a receiving facsimile machine (User/Client 20, fig. 3), to the receiving facsimile machine (User/Client 20, fig. 3).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yajima et al. (US 2002/0016833) discloses a condition where a print job is directed via a PC in the foregoing image output system.

Tanimoto (US 2002/0024684) discloses facsimile apparatus and facsimile communication method.

Crumly (US 7,268,899) discloses secure system for delivery of a fax to a remote user.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen H. Nguyen whose telephone number is (571)270-1229. The examiner can normally be reached on 9:00 AM-6:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, KING Y. POON can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/King Y. Poon/
Supervisory Patent Examiner, Art Unit 2625

/Allen H. Nguyen/
Examiner, Art Unit 2625